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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,490	06/26/2003	Wataru Satake	KON-1803	5669
20311	7590	02/20/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016			LE, HOA VAN	
		ART UNIT		PAPER NUMBER
				1752

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/606,490	SATAKE, WATARU <i>[Signature]</i>
Examiner	Art Unit	
Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 February 2004.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2 and 4-11 is/are pending in the application.  
 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 9-11, 1-2 and 4 with broadest independent claim 9 as the main invention is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

This is in response to Papers filed on 04 February 2004.

I. Claims 9-11 and 1-2 and 4 with broadest independent claim 9 as the main invention and the applied species remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tappe et al (6,413,703).

Tappe et al disclose, teach and suggest silver halide color developing concentrate comprising about 50 g/l of CD3, 4-(N-ethyl-N-2-methylsulfonylaminoethyl)-2-methylphenylenediamine in salt form with sesquisulfate in about 0.185 mol/l and about 60 g/l of sodium carbonate in about 0.566 mol/l, diethylene glycol solvent and about 10 g/l of EDTA, ethylenediaminetetraacetic acid chelating agent. Please see the whole disclosure of the applied reference, especially at Example 4 shows quality result than any and all compositions as broadly claims as shown by applicant in Table A in the showing under Rule 132 on 04 February 2004. Since Tappe et al disclose, teach and suggest the main and essential embodiments of the claimed invention, claims 1-4 are found to be rendered *prima facie* obvious by Tappe et al.

II. Applicant's arguments filed 04 February 2004 have been fully considered but they are not persuasive. Applicant relies on the amendment and showings under Rule 132 for the patentability of the claims. They will be carefully considered and examined in the next paragraphs.

III. Tappe et al use EDTA is read with the general formula A-II. Please see compound A-II-3 which EDTA. Its adjacent homologue is A-II-3 and A-II-9. Accordingly, the arguments are not found to be convincing.

IV. Applicants' declaration under Rule 132 filed on 04 February 2004 has been fully considered but is insufficient to overcome the applied references of the record. The evidence is not commensurate in scope with the claims (Please see MPEP 716.02(d)).

(1) Tappe et al composition in Example 4 shows quality result. Please see Applicant's showing in Table A. At the level of one skilled in the art, the quality result as shown in Table A would be better than those of any and all broadly claimed compositions. Applicant should and is urged and requested to show an evidence to the contrary for a complete and timely consideration and examination during the prosecution of this application. A claim would have no value if someone later show it. It is noted that applicant shows the advantages of Examples 2-5 and 2-12.

(2) However, the instant claims have not been reasonably limited to the tested condition of high temperature as tested and urged with at least 50<sup>0</sup>C, length of time for storage as tested and urged at least 3 months and specific chemical ingredients and their relative proportion as tested and urged. There is no evidence on the record that any and all broadly claimed composition would be able to provide an advantage over Tappe et al composition in Example 4. Applicant should and is urged and requested to show an evidence to the contrary. In the absence of convincing evidence, no value should be given to about (up to -2 and +2% of each individual value and no more than 7% for the total - and + changes in value) the limited tests for Examples 2-5 and 2-12.

(3) The showings in Table A as compared to Examples 2-5 and 2-12 are not a side-by-side comparison with respect to the specific chemical ingredients and their relative proportion. Accordingly, they have and are given no value.

(4) It would like to see test results to be carried out at about 0.001 mg/l of the requisite additive chemical ingredients as broadly claimed other than the concentration of the main color developing agent.

(5) It would also like to see test result to be carried out using the adjacent homologue A-II-3 and A-II-9 as disclosed in the instant application.

For the above reasons the showings are incomplete and much limited in scope than those as broadly claimed.

V. The above comments are not constituted a suggest for an amend to any claim.

VI. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone numbers of the examiner is 571-273-1332. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

(2) mail with a central mail receiving address:

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Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
17 February 2004

HOA VAN LE  
PRIMARY EXAMINER  
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